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UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL V. PETERS

Appeal No. 2003-0807
Application 09/303,360

ON BRIEF

Before JERRY SMITH, RUGGIERO and DIXON, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-10 and 12-17. Claim 11 has been indicated to contain allowable subject matter by the examiner.

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The disclosed invention pertains to an interactive telephone system that utilizes a wireless channel to provide a telephony feature.

Representative claim 7 is reproduced as follows:

7. A telephone system for providing a telephony feature, comprising a phone system controller and a first telephone system interface, wherein:

 said first telephone system interface is coupled between a first telephone handset and a telephone line, said first telephone system interface operable to (i) selectively couple said first telephone handset to said telephone line, and (ii) establish a first wireless control to said phone system controller,

 said wireless control channel operable to carry control signals associated with said telephony feature between said first telephone system interface and said phone system controller, and

 said phone system controller is coupled to said telephone line and operable to (i) receive said first control signals via said wireless control channel, and (ii) process said first control signals to provide said telephony feature.

The examiner relies on the following references:

Bendixen et al. (Bendixen)	4,890,315	Dec. 26, 1989
Armstrong et al. (Armstrong)	5,339,352	Aug. 16, 1994

Claims 7, 8 and 12-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Bendixen. Claims 1-6, 9 and 10 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Bendixen taken alone

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with respect to claims 1-6 and 10, and Bendixen in view of Armstrong with respect to claim 9.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon supports each of the examiner's rejections. Accordingly, we affirm.

We consider first the rejection of claims 7, 8 and 12-17 under 35 U.S.C. § 102(b) as being anticipated by Bendixen. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well

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as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he finds the invention of these claims to be fully met by the disclosure of Bendixen [final rejection, pages 2-4, incorporated into the answer at page 3]. With respect to claim 7, appellant argues that the network of Bendixen does not meet the claimed phone system controller because it is remote from Bendixen's control unit and is only accessible by radio frequency communication. Appellant also argues that Bendixen does not meet the claim requirement that the phone system controller be coupled to the same telephone line as the telephone system interface. Finally, appellant argues that the cellular telephone system of Bendixen does not perform in the same manner as the phone system controller of the invention [brief, pages 6-8]. The examiner responds that the fact that the connection in Bendixen is wireless does not preclude it from meeting the claim recitation of being coupled [answer, pages 4-5]. Appellant responds that a wireless connection cannot couple

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one component to another component as required by claim 7 [reply brief, pages 4-5].

We will sustain the examiner's rejection of claim 7. We first review the manner in which the examiner read claim 7 on the disclosure of Bendixen. The phone system controller is read on the cellular network of Bendixen. The telephone system interface is read on the interface shown in Figure 3 of Bendixen. The telephone line is read on the telephone line connecting the called party and the cellular network. The telephone handset is read on handset 68 in Bendixen. With this reading in mind, it becomes clear that the interface is connected to the telephone line by way of the cellular network while the cellular network is directly connected to the telephone line. Although appellant is correct that the telephone line in this reading is remote from the interface, and the interface is coupled to the phone line by a wireless connection only, we agree with the examiner that such a wireless connection is not precluded by the claimed invention. Claim 7 only requires that elements be "coupled." Bendixen makes it clear that in this art, an electro-magnetic transmission link is considered to be an electrical coupling [note column 4, lines 22-26]. Thus, the term "coupled" in claim 7 is interpreted to include a wireless electrical coupling such as between the

interface of Bendixen and the called telephone line. The fact that elements of Bendixen may not perform in the same manner as elements of appellant's invention does not defeat the rejection. All that is required to support the examiner's rejection is a finding that all the elements of the claim can be found in a single prior art reference. We agree with the examiner's findings based upon the manner in which the examiner has read the invention of claim 7 on the disclosure of Bendixen. None of appellant's arguments persuade us that the examiner's findings are erroneous.

With respect to independent claim 13, appellant relies on the same arguments we considered above with respect to claim 7 [brief, page 9]. With respect to dependent claims 8, 12 and 14-17, appellant simply argues that these claims are patentable either because they depend from claim 7 or claim 13 or because they recite additional limitations that are not taught or shown by Bendixen [brief, pages 8 and 10]. Since we have sustained the examiner's rejection of claims 7 and 13, and since appellant's arguments with respect to the dependent claims are nothing more than a conclusion without any analysis of the limitations of the dependent claims, the dependent claims stand or fall with the claims from which they depend.

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We now consider the rejection of claims 1-6 and 10 based on the teachings of Bendixen taken alone. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443,

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1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

Claim 1 is similar to claim 7 except that it recites the additional limitation of a housing for the switch circuit and the wireless communication interface. The examiner finds that Bendixen teaches the claimed invention except that Bendixen does not specifically teach this housing. The examiner finds that it would have been obvious to the artisan to place the elements in a housing in order to protect the elements from damage [final rejection, page 5, incorporated into the answer at page 3]. Appellant's response in the main brief makes the same arguments we considered above against claim 1. Appellant does not address

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the housing feature in the main brief [brief, pages 11-12]. The examiner responds in the same manner discussed above. The examiner also notes that claim 1 does not preclude a remote system [answer, pages 5-6]. In the reply brief appellant argues that it is not clear how the network of Bendixen could be placed in a housing. Appellant also responds that it is implicit in claim 1 that the interface and the controller are not a remote system since the controller and the interface are coupled to the same telephone line [reply brief, pages 6-8].

We will sustain the examiner's rejection of claim 1. Except for the housing, appellant's arguments with respect to claim 1 have been considered above. Appellant's argument with respect to the housing is not persuasive because the housing of claim 1 does not house the network. Claim 1 recites that the housing houses the switch circuit and the wireless communication interface. These elements correspond to the switch and interface of Figure 3 in Bendixen. We agree with the examiner that it would have been obvious to the artisan to house the switch and interface of the remote unit in a housing as claimed. Appellant's arguments with respect to dependent claims 2-6 and 10 rely on the patentability of independent claims 1 and 7 as discussed above. Therefore, we also sustain the examiner's

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rejection of claims 2-6 and 10.

We now consider the rejection of claim 9 based on Bendixen and Armstrong. The examiner adds Armstrong to teach the feature of obtaining a telephone number and dialing the number for the caller. Appellant makes no additional substantive arguments with respect to the rejection of claim 9. Since we find that the examiner has established a prima facie case of the obviousness of claim 9, and since appellant has not rebutted the examiner's case, we sustain the examiner's rejection of claim 9.

In summary, we have sustained each of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-10 and 12-17 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Jerry Smith
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